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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	066829-5064	5990
9629 7590 05/05/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
DIVECHA, KAMAL B				
ART UNIT		PAPER NUMBER		
2151				
MAIL DATE		DELIVERY MODE		
05/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/913,885

## Applicant(s)

TISSERAND ET AL.

## Examiner

KAMAL B. DIVECHA

## Art Unit

2151

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This Action is in response to communications filed 3/24/08.

Claims 1-7, 10-16 are pending in this application.

Claims 8-9 were previously withdrawn.

**Response to Arguments**

Applicant's arguments filed in the communications have been fully considered but they are not persuasive.

In response filed, applicant argues in substance that:

- a. Lindsay et al. does not teach or fairly suggest terminating the set-up of the call channel once the user message has been communicated (remarks, pg. 4).

In response to argument [a], Examiner respectfully disagrees.

In the response filed, it appears that applicant is addressing the *prima facie case of obviousness* [based on the combination of references] by attacking the references individually and/or by simply attacking a primary reference, i.e. Lindsay et al.

**MPEP 2145 (IV) clearly sets forth:** One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The fact that applicant is attacking the references individually and/or attacking the primary reference only, can be evidenced in the response, e.g. remarks, pg. 4, where applicant

completely disregards and/or avoids the teachings of Ranta reference, which explicitly discloses placing the user message in the signaling message of the call set-up protocol.

In response filed, **applicant admitted** that Lindsay et al. discloses that a network releases a connection in progress or during link set-up. Such a release may be initiated by the network, or, result from authentication rejection, e.g. remarks, pg. 4.

Stated another way, applicant acknowledges that Lindsay is capable and/or teaches terminating the set-up of the call channel once the signaling message has been communicated.

However, applicant fails to note the storage of the user message in the signaling message as in the Ranta reference.

The *prima facie case of obviousness* clearly discloses that Lindsay et al. does not disclose the process of placing the user message in the signaling message of a call set-up protocol, and cites Ranta to disclose this teaching.

Ranta, as set forth in the rejection, clearly discloses placing the user message in the signaling message of a call-set up protocol.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta to place the user message in the signaling message, and terminate the set-up of the call channel once the signaling message, i.e. **signaling message including user message**, has been communicated.

Such termination can be implemented through Lindsay's teachings as acknowledged by the applicant. As such, the combination of Lindsay et al. and Ranta discloses terminating the set up of the call channel once the user message has been communicated as set forth above.

For the at least these reasons, the REJECTION IS MAINTAINED.

**Specification**

The objection presented in the previous office action is withdrawn in light of response filed 3/24/08, more specifically, in light of substitute specification.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 6-7, 10-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1).

As per claim 1, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1); and
- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24; terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied parts of the signaling message (Ranta, col. 2 L13-25).

As per claim 2, Lindsay discloses the process wherein the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claim 3, Lindsay discloses the process wherein a user is authorized to access the dedicated memory by means of specific commands (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28; obviously it requires the commands to access the memory).

As per claim 6, Lindsay does not disclose the process wherein the size of the user message is limited to 35 eight-bit bytes at maximum (i.e. the user message is less than 35 bytes and/or in the range of 0-35 bytes).

Ranta discloses the process wherein the spare field (i.e. the user message that can be inserted into the spare field) is limited to 17 bytes (col. 3 L64 to col. 4 L10: i.e. 17 bytes is in the range of 0-35 bytes).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to limit the size to 35 bytes at maximum.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 1.

As per claim 7, Lindsay discloses the process wherein the user message is communicated in an enciphered form (i.e. encrypted, col. 20 L1-40).

As per claim 11, Lindsay discloses the process wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claims 10, 12 and 15-16, they do not teach or further define over the limitations in claims 1-3, 6-7 and 11. Therefore claims 10, 12 and 15-16 are rejected for the same reasons as set forth in claims 1-3, 6-7 and 11.

2. Claims 4-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1), and further in view of Miller, II (hereinafter Miller, US 5,600,707).

As per claim 4, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and the transmission network is a mobile telephone network (fig. 2, col. 5 L50 to col. 6 L35, fig. 2A, col. 9 L56 to col. 10 L43: mobile telephone network).

However, Lindsay does not disclose the process wherein the mobile telephone is used as modem.

Miller explicitly discloses the process and apparatus, i.e. mobile device that can be used as a modem (col. 1 L30-55, col. 2 L26-61, fig. 1).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to use mobile telephone as a modem.



One of ordinary skilled in the art would have been motivated because it would have enabled communications (Miller, col. 1 L31-65).

As per claim 5, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and using ISDN as the transmission network (col. 6 L60-67).

However, Lindsay does not disclose the process wherein the dedicated memory is in an ISDN-type modem.

Miller explicitly discloses an ISDN-type modem (fig. 1, col. 1 L31-65, col. 2 L62 to col. 3 L22).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to include the dedicated memory in an ISDN-type modem.

One of ordinary skilled in the art would have been motivated because it would have allowed data communications (Miller, col. 1 L31-65).

As per claims 13-14, they do not teach or further define over the limitations in claims 4-5. Therefore, claims 13-14 are rejected for the same reasons as set forth in claims 4-5.

#### **Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pettersson et al., US 6,304,595 B1: Mobile Telephone Modems.
- b. Hameleers et al., US 6,377,799 B1: Interworking function in an internet protocol based radio telecommunications network.

- c. Schiefer et al., US 5,884,175: Handover following in a mobile radio system.
- d. Clarke et al., Us 5,550,914: Communications Signalling network apparatus.
- e. Rosenthal et al., U. S. Patent No. 5,737,701: Automatic Authentication System.
- f. Wallenius, U. S. Patent No. 6,466,786 B1: Call setup in Mobile Communications.

### **Conclusion**

Please Note: The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 2151